APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,401	07/12/2001	Thomas Robert Gruber	1090414-991100	5195

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EXAMINER
HOFFMAN, BRANDON S

ART UNIT	PAPER NUMBER
2136	

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 July 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Drawings

1.   The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5)

because they do not include the following reference sign(s) mentioned in the

description: fig. 2, ref. num 211 is missing. The reference to fig. 2, ref. num 21 should

be ref. num 211. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are

required in reply to the Office action to avoid abandonment of the application. Any

amended replacement drawing sheet should include all of the figures appearing on the

immediate prior version of the sheet, even if only one figure is being amended. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as

per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the

changes are not accepted by the examiner, the applicant will be notified and informed of

any required corrective action in the next Office action. The objection to the drawings

will not be held in abeyance.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Vandergeest (U.S. Patent No. 6,247,127) in view of White (U.S. Patent No. 4,630,201).

Regarding <u>claim 1</u>, <u>Vandergeest</u> teaches a method of conducting a secure

transaction with an on-line service while offline comprising the steps of:

- Issuing a transaction authorization token to a user from an application server for

   the on-line service while the user is online (col. 4, lines 8-16); and

- Preparing an off-line transaction object containing data to specify and request the

   transaction (col. 4, lines 18-20 and col. 5, lines 15-22).

<u>Vandergeest</u> does not teach sending a message to the on-line service, said

message containing the transaction object and the authorization token, upon receipt of

the message, the application server validating the token to authenticate the user and to

authorize the transaction, or executing the transaction object if the transaction is

authorized.

<u>White</u> teaches sending a message to the on-line service, said message

containing the transaction object and the authorization token; upon receipt of the

message, the application server validating the token to authenticate the user and to

authorize the transaction; and executing the transaction object if the transaction is

authorized (fig. 2B and col. 7, line 60 through col. 8, line 9).

It would have been obvious to one of ordinary skill in the art, at the time the

invention was made, to combine sending a message to the on-line service, said

message containing the transaction object and the authorization token, upon receipt of

the message, the application server validating the token to authenticate the user and to

authorize the transaction, and executing the transaction object if the transaction is

authorized, as taught by White, with the method of Vandergeest. It would have been

obvious for such modifications because these limitations take the appropriate steps to

authenticate the processing that was performed offline by the user (see col. 7, lines 60-

62 of White).

Regarding claim 2, the examiner takes Official notice that wherein the token is

issued to the user via an e-mail message sent from the application server is an obvious

modification. Sending attachments via e-mail is well known, and in most cases desired.

Providing a user e-mail messages with attached data allows the user to download the

message and read through at his/her own leisure and save the attachment for later

viewing.

Regarding claim 3, the combination of Vandergeest in view of White teaches

wherein the token is issued to the user via a download operation while the user is on-

line (see col. 4, lines 20-21 of Vandergeest).

Regarding claim 4, the combination of Vandergeest in view of White teaches

wherein the user prepares the transaction object off-line (see col. 4, lines 20-28 of

Vandergeest).

Regarding claim 5, the combination of Vandergeest in view of White teaches

wherein the on-line service comprises the application server, and the user requests the

token for the transaction from the application server (see col. 5, lines 24-40 of

Vandergeest).

Regarding claim 6, the combination of Vandergeest in view of White teaches

wherein the application server accesses a database (see col. 3, lines 40-45 of

Vandergeest).

Regarding claim 7, the combination of Vandergeest in view of White teaches

wherein the token comprises a unique identifier that is generated by the on-line service

when the token is issued (see col. 4, lines 53-57 of Vandergeest).

Regarding claim 8, the combination of Vandergeest in view of White teaches

wherein the token is a one-way encryption of at least one of an identity of the user, a

transaction type, and a data object for which the transaction is authorized (see col. 4,

lines 36-66 of Vandergeest).

Regarding claim 9, the combination of Vandergeest in view of White teaches

wherein the application server receives an incoming message including the token,

checks the token for validity, and accepts or rejects the token (see col. 7, line 60

through col. 8, line 9 of White).

Regarding claim 10, the combination of Vandergeest in view of White teaches

wherein the message delivering the token and off-line transaction from the user to the

application server is an e-mail message delivered to the application server via an

asynchronous e-mail delivery method (see col. 7, line 60 through col. 8, line 9 of White,

the use of e-mail delivery is explained above in claim 2.).

Regarding claim 11, the combination of Vandergeest in view of White teaches

where the asynchronous delivery mechanism is database record synchronization (see

fig. 3A and 3B of White).

Regarding claim 12, the combination of Vandergeest in view of White teaches

where the asynchronous e-mail delivery method comprises a synchronization of data

between a portable computing device and an on-line service (see fig. 1, ref. num 20 and

30 of White).

Regarding claim 13, the combination of Vandergeest in view of White teaches

wherein the token includes data representing a time period during which the token is

valid (see col. 4, lines 47-52 of Vandergeest).

Regarding claim 14, the combination of Vandergeest in view of White teaches

wherein the token includes data representing a valid access duration for the token (see

col. 4, lines 47-52 of Vandergeest).

Regarding claim 15, the combination of Vandergeest in view of White teaches

wherein the token specifies an e-mail audit signature, and said token is valid only if the

transaction is sent from an e-mail program via an e-mail delivery path that matches the

e-mail audit signature (see col. 3, lines 46-52 of Vandergeest).

Regarding claim 16, the examiner takes official notice that wherein an e-mail

address to which the message is sent varies according to an authorized data object and

transaction type is an obvious modification. This is an obvious modification because the

transaction types may be very different. For example, in a banking scheme, one person

is responsible for opening accounts, while another person is responsible for ATM

transactions. It would be desirable to have different addresses for these two different

tasks so the person responsible for opening accounts does not receive emails

pertaining to making a deposit, and vice versa.

Regarding claim 17, the combination of Vandergeest in view of White teaches

further comprising encrypting the transaction object (see col. 4, lines 3-7 of

Vandergeest).

Regarding claim 18, the combination of Vandergeest in view of White teaches

wherein said encrypting comprises issuing a temporary public key that is a one-way

encryption function of an address to which the transaction is to be sent for encryption of

the transaction object (see col. 2, lines 3-7 of Vandergeest).

Regarding claim 19, the examiner takes Official notice that wherein the token is

contained in a body or a header of an e-mail message is an obvious modification. For

reasons similar to that of claim 2, and further reasoning such as when a user forgets

his/her password – the server sends e-mail displaying the forgotten password to the

address on file.

Regarding claim 20, the combination of Vandergeest in view of White teaches

wherein the token and the transaction object are attachments to an e-mail message

(see rejection of claim 2 above).

Regarding claim 21, the combination of Vandergeest in view of White teaches

wherein the application server ensures that the token can only be used once by

authorizing a specific transaction by a specific user on specific data objects (see col. 8,

lines 6-9 of White).

Regarding claim 22, the combination of Vandergeest in view of White teaches

wherein the application server is a web-based application server (see fig. 1, ref. num 24

of Vandergeest).

Regarding claim 23, the combination of Vandergeest in view of White teaches

whereon said transaction is selected from the group consisting of a database

modification, update, adding a file, and editing a file (see fig. 1, ref. num 22 of White, the

table of check numbers can be modified, added, updated, etc.).

Regarding claim 24, the combination of Vandergeest in view of White teaches

further comprising checking out a file, editing the file off-line, and checking in the file as

an e-mail attachment (see col. 6, lines 32-50 of White, as for checking in the file as an

e-mail attachment, the reasoning for its obviousness is stated for claim 2 above).

Regarding claim 25, the combination of Vandergeest in view of White teaches

further comprising authenticating the user with a password and a network identity while

the user is accessing the on-line service (see col. 8, lines 51-55 of White).

Regarding claim 26, the combination of Vandergeest in view of White teaches

wherein the user comprises a software agent that conducts the transaction on behalf of

the user (see col. 8, lines 36-39 of White).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Brandon Hoffman whose telephone number is 571-272-

3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

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